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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,659	11/20/2003	Gert Johannes Brits	034896-0109	7444

7590 07/27/2004  
Foley & Lardner  
Suite 500  
3000 K Street, N.W.  
Washington, DC 20007-5109

EXAMINER

HWU, JUNE

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/716,659

Applicant(s)

BRITS, GERT JOHANNES

Examiner

June Hwu

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Rule 105 requirement.

### DETAILED ACTION

The amendment filed June 21, 2004 has been acknowledged.

The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior Office action.

### 35 USC § 102

In the European Community, the cultivar 'P000306' is described in the European Plant Breeder's Right application number 20020379 filed on March 11, 2002. The application was published on June 15, 2002, more than one year prior to the filing of this instant application. The application is a "printed publication" under 35 U.S.C. 102 because it is accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221,226,210 USPQ 790,794 (CCPA 1981). See also MPEP § 2128. Every two months the Community Plant Variety Office (CPVO) publishes an Official Gazette containing all the information appearing in its Registers, such as applications for protection, proposals for variety denomination and grants of title. Other information the CPVO feels important to the public may also be published in the Gazette. Thus information regarding the claimed variety, in the form of the publication noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to possess or reproduce the claimed plant. *In re Le Grice*, 301 F.2d 929,133 USPQ 365 (CCPA 1962). If one skilled in the art could obtain or reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether 'Siokra' seeds were

Art Unit: 1661

available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the cultivar Siokra disclosed in the cited publications.”).

While the publication cited above discloses the claimed plant variety, a question remains as to whether the reference is enabling. If the plant was publicly available, then the application combined with knowledge in the prior art, would enable one of ordinary skill in the art to obtain or reproduce the claimed plant. The ability of the Office to determine whether the claimed plant was publicly available is limited. Search of electronic databases, the Internet and the Office's collection of retail catalogs have not revealed any evidence that the claimed plant was on sale anywhere in the world. However, the Office's collection of retail catalogs is not comprehensive. Furthermore, the claimed plant may have been sold at the wholesale level, sold under a different name, or even distributed to interested parties free of charge. Since the inventor and assignee of the instant application are in a better position to know when, if ever, the claimed plant was made publicly available, the Examiner is requiring this information in the attached Requirement for Information Under 37 CFR 1.105.

This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

In order to consider whether a 102(b) rejection should be applied, the Examiner is requesting information pertaining to the claimed cultivar.

#### ***Comment***

It is noted in the declaration filed on November 20, 2003 that the cultivar name was originally “‘P 00 06 03’ (Cape Angels Pink)”. It is uncertain if ‘P000306’ and ‘P000603’ are the

Art Unit: 1661

same plant or different plant or if Applicant meant 'P000603'. If 'P000306' is a different plant than what was originally filed on November 20, 2003 then there is a new matter issue. See MPEP 608.04.

***Claim Rejections 35 USC § 112***

Claim 1 remains rejected under 35 USC 112, first and second paragraphs for reasons stated in the previous Office action filed March 19, 2004.

Applicants' amendment dated June 21, 2004 failed to address the following grounds of rejection:

- A. Page 1, lines 17-18 and page 4, lines 3-4, Applicant refers to the female parent as "*Plectranthus saccatus*" when it is a hybrid between tow species. As such, Applicant should delete the first "*saccatus*" on page 1, line 17 and on page 4, line 3.
- B. The specification does not "particularly point out where the variety of plant has been asexually reproduced". Correction is required.
- C. Page 5, line 6 and page 6, line 10, the term "degrees" or its symbol "°" is missing. Correction is necessary.
- D. Page 5, line 11, the recitation with regard to the inflorescence basal length, as "3 cm" is confusing. It is uncertain what part of the inflorescence base is that size when the apical inflorescence is describe as "7 cm". Clarification and correction are needed.

Art Unit: 1661

- E. Page 5, lines 11-12, the recitation describes the individual flower as "22 cm" and then the Applicant describes the floral tube also as "22 cm". The attached photographs appear to show that the floret or individual flower as being larger than the floral tube. Clarification and correction are necessary.
- F. Page 5, line 13 the recitation "6 mm horizontal" is confusing as to what part of the floral tube is that size. Clarification is necessary.
- G. Applicant should set forth in the specification the pedicel's and peduncle's average length, diameter, surface texture and color designation with reference to an employed color chart.
- H. Applicant should set forth in the specification the average lengths of the stamens and anthers. Additionally, Applicant should set forth in the specification the average length and color designation with reference to an employed color chart of the filaments.
- I. Page 6, lines 5-6, the recitation regarding the number and color designation of the capsule is recited again on page 6, line 7. One of these recitations should be deleted.
- J. Applicant should set forth in the specification a botanical description of the capsule's size, surface texture, and color designation with reference to an employed color chart.

### ***Conclusion***

No claim is allowed.

Art Unit: 1661

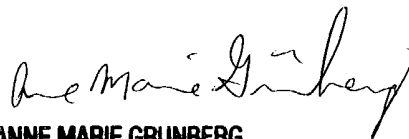
### **Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (571) 272-0977. The Examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Wang, can be reached on (571) 272-0811. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JH

  
**ANNE MARIE GRUNBERG**  
**PRIMARY EXAMINER**

**REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105**

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to determine when, if ever, the claimed plant variety, 'P000306', was publicly available prior to the filing date of the instant application.

In response to this requirement please provide any information available regarding the sale or other public distribution of the claimed plant variety anywhere in the world, including the date(s) of any sale or other public distribution. Also, please provide a copy of the application cited in the attached Office Action. The Office does not maintain a collection of Breeders' Rights documents and they are not readily obtainable electronically. Since the assignee of the instant application is listed by UPOV as applicant, breeder and titleholder of the granted Breeder's Right, it is reasonable to expect that Applicant or the assignee can readily obtain the requested documents and information.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the

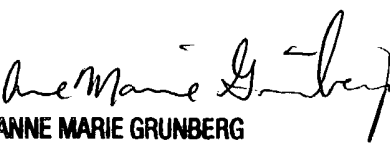


Art Unit: 1661

scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is 3 months.

  
ANNE MARIE GRUNBERG  
PRIMARY EXAMINER